

**IN THE MATTER OF AN OPPOSITION  
by Canadian Olympic Association to  
application No. 659,829 for the trade-mark  
Representation of an Umbrella and Four  
Individuals filed by Waldemar B. Schwauss**

**On June 5, 1990, the applicant, Waldemar B. Schwauss, filed an application to register the trade-mark Representation of an Umbrella and Four Individuals (illustrated below) based on use in Canada since November 5, 1989 for "envelopes and letter heads [sic]" and on proposed use in Canada for the following wares:**

**aprons, book markers, pin-on buttons, balloons, shopping bags, luggage, calendars, caps/hats, coasters, flyers, leaflets, jewelry namely: pins, tie pins, pendants, broaches, bracelets, neck laces [sic] & key chains, belt buckles, labels, fabric labels, decals, name tags, tags, bumper stickers, stickers, adhesive tape, bottle openers, can openers, letter openers, magnetic openers, cups, mugs, plaques, posters, signs, pens, pen holders, pads, writing pads, cards, post cards, stamps, T-shirts, sweat shirts, sweaters, coats, jackets, statues, statuettes, time keeping devices, trinkets, toys namely: dolls, stuffed toys, mobiles, cars, trucks."**

**The application as filed included a disclaimer to the representation of the eleven-pointed maple leaf. The application was advertised for opposition purposes on March 13, 1991. At a late stage in this proceeding, the application was amended to delete the wares "bottle openers, can openers, letter openers, magnetic holders."**

**The opponent, Canadian Olympic Association, filed a statement of opposition on May 7, 1991, a copy of which was forwarded to the applicant on May 28, 1991. The first ground of opposition is that the application does not comply with Section 30(i) of the Trade-marks Act**

because the applicant was aware of the opponent's marks. The second ground is that the application does not comply with Section 30(b) of the Act because the applicant did not use his mark since November 5, 1989 as claimed. The third ground is that the applicant is not the person entitled to registration because he is not a proper applicant.

The fourth ground of opposition is that the applied for trade-mark is not registrable pursuant to Sections 9(1)(n)(iii), 11 and 12(1)(e) of the Act in view of 29 official marks of the opponent. All of the official marks comprise stick figures portraying one or two individuals engaged in a sporting activity, the most pertinent being the representation of what appears to be two wrestlers (illustrated below) for which the Registrar published a notice in the March 23, 1983 issue of the Trade-marks Journal.

The fifth ground of opposition is that the applied for trade-mark is not registrable pursuant to Sections 9(1)(n)(iii), 11 and 12(1)(e) of the Act in view of 21 official marks of Le Comité Organisateur des Jeux Olympiques de 1976 - The Organizing Committee of the 1976 Olympic Games. The sixth ground is that the applied for trade-mark is not distinctive in view of the use of the official marks relied on in respect of the fourth and fifth grounds.

The applicant filed and served a counter statement. As its evidence, the opponent filed an affidavit of John N. Allport. As its evidence, the applicant filed the affidavits of Michael W. Cormier and Donna Harris. Only the applicant filed a written argument and no oral

hearing was conducted.

As for the opponent's first ground of opposition, the legal burden is on the applicant to show its compliance with Section 30(i) of the Act. However, there was an initial evidential burden on the opponent to prove the allegations of fact in support of that ground: see Joseph Seagram & Sons v. Seagram Real Estate (1984), 3 C.P.R.(3d) 325 at 329-330 (T.M.O.B.). Since the opponent has failed to file any evidence on point, the first ground is unsuccessful.

Likewise, the opponent has failed to file evidence directed to its second and third grounds of opposition and they, too, are therefore unsuccessful. The opponent failed to evidence any use of the various marks relied on and thus failed to support its sixth ground of opposition. That ground is therefore also unsuccessful.

The material time for considering the circumstances respecting the fourth ground of opposition would appear to be the date of my decision: see the decisions in Allied Corporation v. Canadian Olympic Association (1989), 28 C.P.R.(3d) 161 (F.C.A.) and Olympus Optical Company Limited v. Canadian Olympic Association (1991), 38 C.P.R.(3d) 1 (F.C.A.). The opponent is not required to evidence use and adoption of each official mark relied on: see page 166 of the Allied decision and pages 7-9 of the unreported opposition decision in The Canadian Council of Professional Engineers v. Parametric Technology Corporation (S.N. 602,455; January 31, 1995). Finally, the test to be applied is one of straight comparison of the marks in question apart from any marketplace considerations such as the wares, services or trades involved: see page 166 of the Allied decision and page 65 of the decision in Canadian Olympic Association v. Konica Canada Inc. (1990), 30 C.P.R.(3d) 60 (F.C.T.D.); reversed on other grounds (1991), 39 C.P.R.(3d) 400 (F.C.A.). As stated in Section 9(1)(n)(iii) of the Act, that test is whether or not the applicant's mark consists of, or so nearly resembles as to be likely to be mistaken for, the official mark. In other words, is the applicant's mark identical to, or almost the same as, the official mark?

As noted above, the most relevant of the opponent's official marks is the representation of what appears to be two wrestlers. Thus, a consideration of the issue arising pursuant to

Section 9(1)(n)(iii) respecting that mark will effectively decide the outcome for all of the official marks relied on in the opponent's fourth ground. The applicant's mark is not identical to the opponent's official mark. Furthermore, although there are some superficial similarities between the two marks, I also consider that the applicant's mark is not almost the same as the opponent's official mark.

The applicant's mark includes a representation of four individuals whereas the opponent's mark includes two. Although the figures in both marks have detached rounded heads, the upper and lower trunks of the opponent's figures are detached whereas each of the applicant's figures has a unitary body. More importantly, the stance of the opponent's figures differs substantially from that of the applicant's figures. As noted, the opponent's figures appear to be two wrestlers. The applicant's figures, on the other hand, appear to be four individuals (possibly a family) including a child and one person in a wheelchair holding hands. Most importantly, the applicant's mark is dominated by the representation of a large umbrella covering the four individuals. Thus, I find that the applicant's mark does not offend the provisions of Sections 9(1)(n)(iii) and 12(1)(e) of the Act and the fourth ground of opposition is therefore unsuccessful.

In previous oppositions, the opponent has contended that such a ground should be decided in its favor in view of the decision of Mr. Justice Rothstein of the Federal Court, Trial Division in Canadian Olympic Association v. Health Care Employees Union of Alberta (1992), 46 C.P.R.(3d) 12. In the Health Care Employees decision, Mr. Justice Rothstein apparently held that the concept of a family or series of trade-marks applicable in assessing the issue of confusion between trade-marks is also applicable when considering the issue of resemblance arising pursuant to Section 9 of the Act. Inexplicably, he also apparently held that, unlike the case with a family or series of trade-marks, the owner of a family or series of official marks need not evidence use of those marks in order to rely on them. Finally, without a clear explanation, Mr. Justice Rothstein imported the test of "first impression and imperfect recollection" as applied to Section 6 of the Act to Section 9 of the Act.

I strongly disagree with Mr. Justice Rothstein's approach to Section 9 of the Act. The test of resemblance in Section 9 is not the same as the test for confusion set out in Section 6 of the Act. The test in Section 6 is a marketplace test in which various circumstances are considered such as the inherent distinctiveness of the marks at issue, the extent to which they have become known and the natures of the wares, services and trades. The test in Section 9 is one of straight comparison of the marks at issue apart from any marketplace considerations. As stated by Mr. Justice Denault in Canadian Olympic Association v. Konica Canada Inc. (1990), 30 C.P.R.(3d) 60 at 65 (F.C.T.D.):

**Resemblance of the official mark and the adopted mark  
is the only factor to be considered....**

In my view, it is far from clear that the concept of a family or series of marks can be imported into the resemblance test for Section 9. Even if it can, it is even less clear that there should be no requirement for an official mark owner to evidence use of the various official marks comprising the alleged family. This is especially so in the present case where the opponent has also relied on 21 official marks apparently owned by a third party, those 21 marks being virtually identical to 21 of the marks in the opponent's family of 29. It would seem that the existence of a third party family of similar marks would negate any proprietorial significance in the opponent's alleged family, at least where the opponent has failed to evidence use of its family of marks.

In my view, Mr. Justice Rothstein's decision represents an unwarranted extension of the already very broad protection afforded to official marks by the clear wording of Sections 9 and 12 of the Trade-marks Act. It seems manifestly unfair to broaden that protection by reading in concepts applicable to Section 6 of the Act without providing clear reasons for doing so. However, the Chairman of the Opposition Board found in his decision in Canadian Olympic Association v. Express Services, Inc. (1993), 51 C.P.R.(3d) 102 (T.M.O.B.) that although he, too, disagreed with Mr. Justice Rothstein's decision, he could not unequivocally state that it was clearly wrong. I find myself in the same position.

The net result of the foregoing is that I am obliged to consider the opponent's 29 official marks consisting of similar stick figures as comprising a family or series of marks. The common features of the members of the opponent's family of marks are that they consist of one or two stick figures engaged in a sporting activity, each figure having a detached round head and an upper body portion detached from the lower portion. Although this finding effectively broadens the test for resemblance in the present case, it does not greatly advance the opponent's case since the applicant's mark is not a member of the opponent's family. As noted above, the applicant's mark consists of four individuals having unitary bodies. More importantly, those four figures are clearly not engaged in a sporting activity. Of particular note is the fact that the applicant's mark is dominated by the representation of an umbrella.

The applicant contended that a further surrounding circumstance in the present case is the state of the register evidence introduced by means of the Cormier affidavit. Mr. Cormier's affidavit evidences 69 registrations for trade-marks comprising or including fanciful representations of human figures. The applicant submits that this shows that there has been common adoption of such marks in the marketplace and that therefore minor differences should suffice to distinguish them. Such evidence, although relevant to the marketplace test for confusion set out in Section 6 of the Act, is irrelevant with respect to the test for resemblance set out in Section 9 of the Act. As noted above, the only factor to be considered is the resemblance between the marks at issue apart from any marketplace considerations. I have some sympathy for the applicant's position since it would seem fair and reasonable to consider state of the register evidence in this case in view of Mr. Justice Rothstein's unwarranted importation of the concept of a family or series of marks into the Section 9 resemblance test. However, the authorities suggest otherwise.

As for the fifth ground of opposition, the 21 third party official marks relied on are virtually identical to 21 of the 29 official marks of the opponent relied on in the third ground. Each of the 21 third party marks is essentially a negative image of a counterpart official mark owned by the opponent. Thus, a consideration of the issue of resemblance pursuant to Section

**9 respecting this ground leads to the same result as for the third ground. The fourth ground is therefore also unsuccessful.**

**In view of the above, I reject the opponent's opposition.**

**DATED AT HULL, QUEBEC, THIS 28<sup>th</sup> DAY OF FEBRUARY, 1995.**

**David J. Martin,  
Member,  
Trade Marks Opposition Board.**